

REMARKS

Claim 22, which is identical to claim 41, now canceled, is the only independent claim in the application. Applicants made this amendment to simplify issues on appeal if the Examiner continues to reject claim 22.

Claim 43 is rejected under 35 USC 112, second paragraph. The Examiner states that the phrase “through the fabric” seems to contradict the limitation of applying the binder in a linear manner. This rejection is respectfully traversed.

Figure 2 of the specification shows a binder distributed in a line-like manner and extending “through the fabric.” There is nothing contradictory that a binder applied in a linear manner, e.g., a string-like binder, could traverse “through the fabric” as shown in Figure 2.

Claims 22-28 and 40-44 were rejected as being obvious over Kishi in view of Homma. This rejection is respectfully traversed.

On page 3, lines 3-5 from the bottom, the Examiner alleges:

It is the examiner’s position that a binder is equivalent to a sizing agent because a binder is a polymeric resin applied to yarns or fabrics to improve their stiffness and strength.

The Examiner’s position that “a binder is *equivalent* to a sizing agent” (emphasis added) is contrary to MPEP 2144.06, which states:

In order to rely on equivalence as rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant’s disclosure or the mere fact that the components at issue are functional or mechanical equivalents.

The Examiner has alleged “equivalence” without first showing that the equivalency was recognized in the prior art. Second, the mere fact that a binder and sizing agent could be “functional or mechanical equivalents” does not establish “equivalency” supporting an obviousness rejection. Finally, if the Examiner continues to think that the “binder” is equivalent to the “sizing agent” in claim 22, then he would be ignoring a limitation of claim 22, contrary to

MPEP 2143.03. “To establish a *prima facie* of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *Id.*, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

In particular, with respect to claim 41, which is identical to amended claim 22 in this Amendment, the Examiner argued that one would have added Homma’s binder to Kishi because “[s]uch a combination would have been motivated by the desire to reduce the twisting of Kishi’s yarns.” Page 4, lines 8-10, of the Action.

Applicants respectfully and succinctly submit the following:

(i) Kishi obtains cover factor in the range of 97-99.9% (col. 3, line 30 of Kishi) and does *not* have a problem of yarn twisting in the prepreg. So there would have been *no* motivation for a person of ordinary skill in this art “to reduce the twisting of Kishi’s yarns” when there is *no* problem to solve in Kishi in the first place.

(ii) MPEP 214.01 states, “The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Neither Kishi nor Homma suggests the desirability of the combination put forth by the Examiner.

Applicants respectfully submit that the Examiner is simply hypothesizing that one would have added Homma’s binder to Kishi because “[s]uch a combination would have been motivated by the desire to reduce the twisting of Kishi’s yarns.”

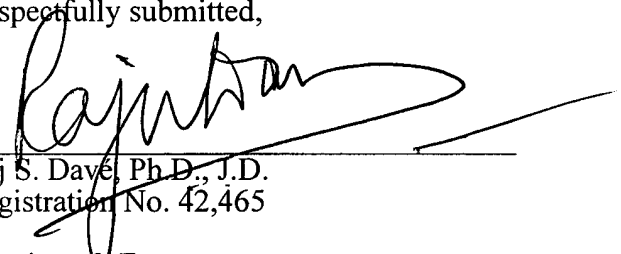
Attached is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned **“Version with markings to show changes made.”**

In the event that the transmittal letter is separated from this document and the Patent & Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952**, referencing 360842003400.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims

Cancel claims 41 and 42 without prejudice or disclaimer.

22. (Six Times Amended) A cloth prepreg made by a wet process comprising (i) a reinforcing fiber-containing woven fabric impregnated with a resin, (ii) a binder distributed in a line-like manner to maintain yarn flatness and (iii) [optionally] a sizing agent on the reinforcing fiber,

the fabric comprising a number of crossing points of warp and weft in a range of from 2,000 to 70,000/m², said warp and said weft being substantially free from twist, a width of 3 to 20 mm and a flatness as defined by a ratio of yarn width to yarn thickness of at least 20, and the prepreg having a cover factor of at least 90%.